

REMARKS

Claims 2, 6-11, 13-15, 17 and 19 are pending in the instant application. Claims 2, 6, 9 and 13-15 have been rejected. Applicants have amended Claims 2 and 6. Support for these amendments can be found in the specification. Claims 10, 17 and 19 have been withdrawn as being directed to non-elected subject matter. After entry of these amendments, Claims 2, 6-11, 13-15, 17 and 19 will remain pending.

Rejection of Claims 2, 9, 10, 13 and 14 under 35 USC §112, first paragraph

The Examiner has rejected Claims 2, 9, 10, 13 and 14 under 35 USC §112, first paragraph as allegedly lacking enablement. The Examiner alleges that the specification is only enabling for using the compounds of formula I with R¹ as a substituted carbonyl moiety, R⁶ as an optionally substituted phenyl, and R⁹ as hydrogen or -(CH₂)₃NH₂ and R⁸ as an optionally substituted phenyl.

Applicants respectfully traverse this rejection. Without conceding the correctness of the Examiner's rejection, but to advance the prosecution of the instant application, Applicants have amended Claim 2 to narrow the scope of R^{10a}, R^{10b}, R^c and R^{c'}. Support for these amendments can be found in the specification, specifically on page 18, lines 18-19, 25 and 29. Please note that in Applicants' response of October 06, 2008, Claim 2 was amended to limit the definitions of R⁶, R⁸ and R⁹ to hydrogen, and the scope of R¹ was greatly reduced.

With regard to the Examiner's objection to the scope of R¹, Applicants would like to direct the Examiner's attention to compound 1-6 on page 51 and compound 1-11 on page 53, which exemplify substituted sulfoxide derivatives. Applicants submit that these specific examples, in combination with the generic schemes, examples and teachings in the instant application would enable one skilled in the art to make the sulfoxide derivatives embodied in currently amended Claim 2.

Furthermore, Applicants respectfully contend that the current focus of Claim 2 mirrors the specific compounds that have been made and tested to exemplify the claimed invention. Applicants respectfully contend that the specific example compounds whose syntheses and testing is described in the application and the Reaction Schemes set out in the application together would readily allow one of ordinary skill in the art to make, use and test the claimed compounds without any undue additional experimentation.

In light of these amendments, Applicants respectfully request the rejection of Claims 2, 9, 10, 13 and 14 under 35 USC §112, first paragraph, be withdrawn.

Commonly Owned Subject Matter

Applicants contend that the inventions contained in the instant application and in the application of Serial Number 10/539,512 were both assigned to Merck & Co., Inc.

Nonstatutory Obviousness-type Double Patenting Rejection of Claims 2, 9, 11, 13, 14 and 15

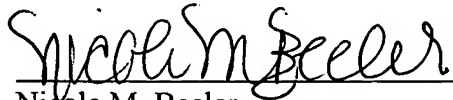
The Examiner has provisionally rejected Claims 2, 9, 11, 13, 14 and 15 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-5, 10, 12, 13 and 14-16 of co-pending Application No. 10/539,512. As these rejections are provisional rejections based on pending applications which are still undergoing prosecution and wherein no allowable subject matter has yet been identified, Applicants respectfully request that this rejection be held in abeyance.

Provisional Rejection of Claim 6 under 35 U.S.C. §101

The Examiner has provisionally rejected Claim 6 under 35 U.S.C. §101 as claiming the same invention as that of Claim 6 of copending Application No. 10/539,512. Applicants have cancelled the compound 1-acetyl-4-(2,5-difluorophenyl)-6-phenyl-1,2,3,6-tetrahydropyridine from the instant application. Accordingly, this rejection should be rendered moot and Applicants respectfully request that the provisional rejection of Claim 6 under 35 U.S.C. §101 be withdrawn.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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